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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/701,288	11/28/2000	Rudolf Ritter	PM275385	8925

22850 7590 08/25/2003

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ALEXANDRIA, VA 22314

EXAMINER

MCCLELLAN, JAMES S

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 08/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/701,288

Applicant(s)

RITTER ET AL.

Examiner

James S McClellan

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Amendment

1. Applicant's submittal of an amendment was entered on July 3, 2003, wherein:
 - claims 1-17 are pending;
 - claims 1-10 have been amended; and
 - claims 11-17 have been added.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 1, 2, 4, 6, 7, 9, 11, 12, 15, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over International Publication No. WO 98/34203 (WO '203) in view of U.S. Patent No. 6,250,557 (Forlund et al.)

In regards to independent **claim 1**, WO '203 discloses a payment transaction method between a customer with a portal mobile device (412, see Figure 8) and a service point, comprising: determining a total transaction (see last paragraph of page 11) to be paid and a transaction identification assigned to the total transaction amount (see Figure 6, 200) at a payment terminal of the service point, informing the customer about the total transaction amount (see last paragraph of page 11) and the transaction identification (200), wherein, the payment

Art Unit: 3627

terminal (414), during determination of the transaction identification; the payment terminal (414) transmits a payment request (200) which comprises a service point identification (inherent) and total transaction amount (inherent), via a second contactless device interface (426) to the mobile device; and a payment record is prepared in the mobile device (412), the payment record including a linking of payment request to a customer identification (inherent in authorization of step 202) of the customer, and being transmitted (step 202) from the mobile device (412) via the mobile contactless device interface (424) to the payment terminal (414); **[claim 2]** during the transmission of the transaction identification, entered by the customer, from the mobile device (412) to the payment terminal (414) a sender identification is co-transmitted (it is inherent during a transaction that a transmission will provide identification of the sender), and wherein the payment terminal (414) transmits payment request to the mobile device (412) established through the sender identification; and **[claim 4]** in the mobile device (412) data about the type of payment are added to the payment record before transmission of the payment record to the payment terminal.

In regards to independent **claim 6**, WO' 203 discloses a payment transaction system comprising a plurality of portable mobile device (412, inherent that the system utilizes more than one device) and a plurality of payment terminals (414, inherent that the system utilizes more than one terminal) at a service point, wherein, each of the mobile devices (412) and the payment terminals (414) includes at least one processor (inherent) and one contactless device interface (424, 426) the mobile devices (412) and the payment terminals (414) communicate with one another via the contactless device interfaces, each of the payment terminals (2) includes a transaction identification module configured to determine the transaction identification for a

Art Unit: 3627

payment transaction, each payment terminals (414) includes a payment request module configured to transmit a payment request, comprising a service point identification (inherent) and the total transaction amount of the payment transaction, determined through the received transaction identification, via a second contactless device (426) to the mobile device (412) from which the transaction identification was received, and each of the mobile devices (412) includes a payment record module configured to prepare a payment record comprising a payment request (202), received by the mobile device (412) from a payment terminal (414), and a customer identification of the respective customer, and transmits the prepared payment record via the contactless device (424) to the payment terminal from which the payment request was received; **[claim 7]** the mobile devices (412) each comprise means to co-transmit a sender identification (it is inherent that sender identification is sent such that the payment terminal can identify the customer) when transmitting the transaction identification, entered by the customer, to the payment terminal (414) and wherein the payment request module comprises means to transmit the payment request to the mobile device (412) determined through the sender identification; **[claim 9]** the payment record module comprises means to add to the payment record data on the type of payment (see Figure 3) before transmission of the payment record to a payment terminal (414).

Regarding **claims 11 and 12**, WO '203 discloses a method of performing a payment transaction as described above in detail for similar limitations in claims 1, 2, 6, and 7.

Regarding **claims 15 and 16**, WO '203 discloses a system for performing a payment transaction as described above in detail for similar limitations in claims 1, 2, 6, and 7.

Art Unit: 3627

Regarding claims 1, 6, 11, and 17, WO '203 discloses wireless communication between the mobile unit and the payment terminal but fails to disclose the payment terminal sending a transaction identification and receiving it returned by the mobile unit before the payment terminal sends a transaction request.

Forslund et al. discloses a payment center sending a transaction identification (see column 4, lines 45-47) and receiving it returned by a mobile unit before the payment terminal sends a transaction request (see column 4, lines 57-61 and the paragraph bridging columns 4-5).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify WO '203 with preemptive transaction identification steps taught by Forslund et al., the additional step of identifying the transaction identification prior to the transaction request provides the mobile user with the desired ability to determine when the transaction will occur.

4. Claims 3, 8, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO '203 in view of Forslund et al. in view of Official Notice.

WO '203 in combination with Forslund et al. fail to expressly disclose increasing wireless transmitting power between the two communication interfaces. The Examiner takes Official Notice that it is old and well known to increase transmitting power between two communication devices when contact is not originally available.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify WO '203's modified device with transmission power increase as is well known in the art, because increasing transmission power will increase the overall range of

Art Unit: 3627

communication between the two devices and thereby improve overall operation of the communication system.

5. Claims 5, 10, 14, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO '203 in view of Forslund et al. as applied to claim 1, 6, 11, and 15 above, and further in view of U.S. Patent No. 6,016,476 (Maes et al.).

WO '203 in combination with Forslund et al. show all the claimed elements as set forth above except for the use of a biometrics feature for identifying a user.

Maes et al. teaches the use of a biometrics feature for identifying a user during an electronic transaction (see sensor 40 in column 5, lines 54-67).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify WO '203's modified device with a biometric sensor as taught by Maes et al., because a biometric sensor provides a secure means of identifying the user, wherein reducing the likelihood of an improper transaction.

Response to Arguments

6. Applicant's arguments July 3, 2003 have been fully considered but they are not persuasive.

On page 11, first paragraph, Applicant notes claim 10 has been amended to remove the multiple dependency language. The objection to claim 10 is withdrawn.

On page 11, second paragraph, Applicant notes that claims have been amended to overcome the previous 35 U.S.C. § 112 rejections. The 35 U.S.C. § 112 rejections are withdrawn.

On page 11-15, Applicant argues that the combination of WO '203 and WO '524 fail to disclose the transmission by the mobile unit of a transaction identification to the payment terminal prior to the payment terminal's transaction request as set forth in claims 1 and 6. In view of the new grounds of rejection the argument is moot.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jim McClellan whose telephone number is (703) 305-0212. The examiner can normally be reached on Monday-Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski, can be reached at (703) 308-5183.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

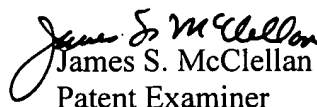
Any response to this action should be mailed to:

Commissioner of Patent and Trademarks
Washington D.C. 20231

or faxed to:

(703) 305-7687 (Official communications) or
(703) 746-3516 (Informal/Draft communications).

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive,
Arlington, VA, 7th floor receptionist.


James S. McClellan
Patent Examiner
A.U. 3627

jsm; January 21, 2002